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10/705,490	11/10/2003	Michael Danner	308-19	5130

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EXAMINER

CINTINS, IVARS C

ART UNIT	PAPER NUMBER
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1724

DATE MAILED: 02/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/705,490

Applicant(s)

DANNER, MICHAEL

Examiner

Ivars C. Cintins

Art Unit

1724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 17-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Art Unit: 1724

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-16, drawn to a filter assembly, classified in class 210, subclass 198.1.
- II. Claims 17-20, drawn to a valve, classified in class 137, subclass 625.47.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the filter assembly of Group I does not require the three way valve of Group II, as evidenced by claim 13. The subcombination has separate utility such as in a beverage dispenser.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Thomas Galgano on February 10, 2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-16. Affirmation of this election must be made by Applicant in replying to this Office action. Claims 17-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

Art Unit: 1724

pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The presence of a filter media in the recited device appears to be critical and essential to the practice of the invention, in order for this device to function as a “filter assembly.” Since this essential material is not positively recited in claims 1-16, these claims are not enabled by the disclosure. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Applicant is advised that an amendment positively reciting the presence of filter media in the recited container (e.g. by deleting the term “for” in line 2 of claims 1, 6, 10 and 13) would overcome this rejection.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 1-16 fail to recite the apparently essential limitation that the recited container contains some type of filter media; and therefore, these claims fail to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Again, Applicant is advised that an amendment positively reciting the presence of filter media in the recited container (e.g. by deleting the term “for” in line 2 of claims 1, 6, 10 and 13) would overcome this rejection.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1724

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2 and 10 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Brett (U.S. Patent No. 3,809,247). The reference discloses a filter assembly comprising a three way valve having a water inlet **25**, a water outlet **26**, a waste water outlet **27**, and a flow diverter **36** which is capable of diverting flow both horizontally and vertically in the recited manner (see Fig. 3).

Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Boyer (U.S. Patent No. 657,851). The reference discloses a filter assembly comprising a cylindrical container **J**, an agitator assembly **E** having an axis of rotation substantially coaxial with the central axis of the container, a removable cover **j** with a handle **C'** coupled to the agitator; and this is all that is required by claim 13.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brett in view of Boyer. Brett discloses the claimed invention with the exception of the recited agitator. Boyer discloses a filter having an agitator of the type recited. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system of Brett with the agitator of Boyer, in order to assist in the cleansing of the filter media of this primary reference system.

Art Unit: 1724

Claims 4, 12 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brett in view of Boyer as applied above, and further in view of Melyon (U.S. Patent No. 5,597,482). The modified primary reference discloses the claimed invention with the exception of the recited ultraviolet sterilizer. Melyon teaches providing a water filter with a UV sterilizer. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system of the modified primary reference with the UV sterilizer of Melyon, in order to destroy any undesirable microorganisms in the water undergoing treatment in this modified primary reference system.

Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brett in view of Jensen et al. (U.S. Patent No. 6,076,554). Brett discloses the claimed invention with the exception of the recited type of flow diverter. Jensen et al. discloses a three way valve (see Fig. 1) having a flow diverter comprising a discontinuous cylinder (i.e. element 52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the three way valve of Jensen et al. for the three way valve of Brett, since this secondary reference three way valve is capable of controlling the flow of diverse liquid streams in substantially the same manner as the three way valve of the primary reference, to produce substantially the same results. Such modification is deemed to be especially obvious in view of the disclosure by Jensen et al. that this secondary reference valve can be used in connecting a pump and a filter to a swimming pool (see col. 2, lines 33-34).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brett in view of Jensen et al. as applied above, and further in view of Boyer. The modified primary reference discloses the claimed invention with the exception of the recited agitator. Boyer discloses a filter

Art Unit: 1724

having an agitator of the type recited; and it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system of the modified primary reference with the agitator of Boyer, in order to assist in the cleansing of the filter media of this modified primary reference system.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brett in view of Jensen et al. and Boyer as applied above, further in view of Melyon. The modified primary reference discloses the claimed invention with the exception of the recited ultraviolet sterilizer. Melyon teaches providing a water filter with a UV sterilizer; and it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system of the modified primary reference with the UV sterilizer of Melyon, in order to destroy any undesirable microorganisms in the water undergoing treatment in this modified primary reference system.

Mittersteiner Urzua (U.S. Patent No. 5,522,430) discloses a similar multi-way valve.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to I. Cintins whose telephone number is (571) 272-1155. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Duane Smith, can be reached at (571) 272-1166.

The centralized facsimile number for the USPTO is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 1724

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ivars C. Cintins
Primary Examiner
Art Unit 1724

I. Cintins
February 11, 2005